

REMARKS

This responds to the Final Office Action dated March 4, 2009.

Claims 1, 15, 18, 19, 20, 34, and 45 are amended, no claims are canceled, and no claims are added; as a result, claims 1, 4-12, 15, 18-25 and 30-55 are pending in this application.

§ 103(a) Rejection of the Claims

Claims 1, 4-12, 15, 18-25 and 30-55 were rejected under 35 U.S.C. § 103(a) as being obvious over Estipona (U.S. Patent No. 6,795,973) in view of Schrader et al. (U.S. Patent Application Publication No. 2002/0157101).

A) Applicable Law for Rejections under 35 U.S.C. §103(a)

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.¹

"[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."² If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The USPTO Board of Patent Appeals and Interferences provides guidance in evaluating a patent application for obviousness in the *Ex parte Wada* ³. In this appeal the Board reversed a 35 USC §103 rejection of claims as the Examiner failed to explain where or how the cited references taught or suggested each and every feature of the claimed invention, stating:

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention including all its limitations with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Thus, "obviousness requires a suggestion of all limitations in a

¹ KSR, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

² KSR, 550 U.S. at ___, 82 USPQ2d at 1396.

³ *Ex parte Wada* Appeal 2007-3733.

claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). *Emphasis added.*

B) The rejection of claims 1, 4-12, 15, 18-25 and 30-55 under 35 U.S.C. § 103(a) as being unpatentable over Estipona in View of Schrader is improper.

Claims 1, 4-12, 15, 18-25 and 30-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Estipona in view of Schrader. Because a proper *prima facie* case of obviousness has not been properly established by the Office, the Appellant respectfully traverses.

Claim 1

As amended Applicant’s claim 1 recites:

A method of transmitting data, the method comprising:
transmitting a video program and at least one trigger employing a first television channel operating at a first frequency within a range of frequencies assigned to service channels; and
transmitting enhanced television content coupled to said video program employing a second channel operating at a second frequency, wherein the second frequency is outside the range of frequencies assigned to the service channels, and wherein the second channel is a signaling channel.

With respect to claim 1, the method includes transmitting on multiple channels, wherein a *first television channel operates at a first frequency within a range of frequencies assigned to service channels*, and a *second channel operates at a second frequency...outside the range of frequencies*

assigned to the service channel. The applied references fail to satisfy these limitations. The Examiner admits that “Estipona fails to disclose *a first frequency within a range of frequencies assigned to service channels*, and also fails to disclose *transmitting enhanced television content coupled to said video program employing a second channel operating at a second frequency, wherein the second frequency is outside the range of frequencies assigned to the service channels*”⁴. The Examiner proposes to combine Estipona with Schrader to remedy these deficiencies. Schrader, however, does not teach or suggest service channels and therefore fails to satisfy the deficiencies of Estipona.

The system of Schrader provides for broadcast television programming and Internet Protocol (IP) data over different broadcast channels⁵, but does not discuss service channels and other channels. The claim specifically recites that a range of frequencies is assigned to a service channel and that the enhanced television content is transmitted on a channel that is outside of that range. In other words, the second channel is not a service channel. Applicant respectfully disagrees with the Examiner’s statement that “a channel outside the range of the first frequency, i.e., outside the range assigned to the service channel, is de facto used to carry IP content.”⁶ This is not the case. The claim recites the second frequency is *outside the range of frequencies assigned to the service channels*. Here the service channels are plural and correspond to the range of frequencies, and the second channel does not operate at a frequency within that range. It is not sufficient that the first and second channels have different frequencies, but the second channel is to operate at a frequency NOT in the range of frequencies assigned to service channels. Referring to the teaching of Schrader, there is no discussion of a range of frequencies assigned to a service channel, and no discussion of frequencies outside that range. Therefore, the Examiner is using impermissible hindsight to interpret Schrader as satisfying the claim limitations.

In order to further clarify Applicant’s claimed invention, Applicant amends claim 1 to further recite that the second channel is a signaling channel. As the use of a signaling channel for transmission of enhanced television content is not disclosed in the applied references.

⁴ Final Office Action, pages 3-4.

⁵ Schrader, paragraph [0028].

⁶ Final Office Action, page 2-4.

The arguments provided with respect to claim 1 are applicable to independent claims 15, 34, and 45, as well as to claims depending thereon. For at least these reasons, Applicant respectfully submits that the Office has failed to establish a proper *prima facie* case of obviousness, and requests reconsideration and withdrawal of these rejections.

Claim 15

Still further, Applicant respectfully disagrees with the Examiner's characterization of the applied references as teaching Applicant's claim 15. As amended claim 15 recites:

15. A system for transmitting television content and enhanced television content, comprising:

a plurality of modules, each module comprising instructions retained on at least one machine-readable storage medium, that when executed by a machine perform identified operations, wherein the modules comprise:

an information transfer module to

access video information containing said enhanced television content and said video program,

remove said enhanced television content from said video information to produce said video program comprising non-enhanced video information; and

a transmitter to

transmit said video program and at least one trigger employing a first television channel operating at a first frequency within a range of frequencies assigned to service channels; and
transmit enhanced television content coupled to said video program employing a second channel operating at a second frequency, wherein the second frequency is outside the range of frequencies assigned to the service channels.

Applicant respectfully disagrees with the Examiner's characterization of the applied references as teaching the elements of claim 15. Specifically, the Examiner interprets Estipona as teaching a *transmitter to remove said enhanced television content from said video information to produce said video program comprising non-enhanced video information*, paraphrasing Estipona as stating that "triggers are extracted at the receiver for producing the video program comprising non-enhanced video information."⁷ Applicants respectfully submit that there is no commonality between the recited claim limitations and the Examiner's paraphrase of Estipona for at least the reasons that, i) Applicant's claim is directed to a *transmitter*, while the teachings of Estipona are directed to a receiver; ii) Applicant's claim recites an information transfer module to *remove enhanced television content*, whereas Estipona teaches reading a trigger in a data stream and using a proxy unit to retrieve resources from a storage medium;⁸ iii) Applicant's claim recites *an information transfer module to ... remove said enhanced television content ... to produce ... non-enhanced video information*, while Estipona teaches receiving the non-enhanced data stream with triggers which cause the system to retrieve enhanced data; and iv) Applicant's claim recites *a transmitter to transmit* the produced non-enhanced video information on a *first channel* and *to transmit* the removed enhanced television content on a *second channel*, whereas Estipona teaches receiving a data stream with triggers and accessing stored content. Therefore, Estipona does not teach at least this element of claim 15.

The arguments provided with respect to claims 1 and 15 are applicable to independent claims 34 and 45, as well as to claims depending thereon. For at least these reasons, Applicant respectfully submits that the Office has failed to establish a proper *prima facie* case of obviousness, and requests reconsideration and withdrawal of these rejections.

⁷ Final Office Action, page 5.

⁸ Estipona, col. 5, lines 40-63, col. 7, lines 5-24.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4059 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date April 13, 2009

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 13, 2009.

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